

**REMARKS**

By this amendment claims 1, 10 and 24 have been amended. Accordingly, claims 1, 6-8, and 10-33 remain pending in the present application.

The Office Action objects to the drawings as being informal. A set of replacement formal drawings is attached hereto which address the grounds of informality objected to by the Examiner. Additionally, the previously omitted decision label "N" at element 70 in Fig. 8, the reference numeral 114 in Fig. 9, and the decision label "Y" at element 115 in Fig. 9 have been added.

Claims 1, 6-8, and 10-11, and 16-33 have been rejected under 35 U.S.C. 103(a) as being unpatentable over the book entitled A Guide to the Project Management Body of Knowledge, by the Project Management Institute, edited by William R. Duncan, pub'd. 1996, hereinafter referred to as "Duncan," and further in view of Levinson (U.S. Patent No. 6,047,260).

A. Tasking Horizon

Claim 1 recites, *inter alia*, "setting a tasking horizon based on a predetermined time interval," "for each task related event expected to occur during said tasking horizon, assigning the task corresponding with the respective task related event if said corresponding task has not yet been assigned," and "receiving a respective predicted date for each task related event expected to occur during said tasking horizon." Similarly, independent claim 10 recites "a management module . . . for setting a tasking horizon" and "at least one task assignment station for receiving information of at least one task having a task related event expected to be performed during said tasking horizon."

The term “tasking horizon” as recited in claims 1 and 10 is described in the present application as being “designed to be a realistic planning window that corresponds to the length of time most employees can plan their work” (specification, p. 6, lns. 8-12; p. 11, last 2 lines through page 12, ln. 6). The reason for this is that “the most effective planning is generally limited to a predetermined period of time, which is likely to be much smaller than the project time period.” (*Id.*) (emphasis added). Thus, each tasking horizon is a fixed window of time within which any of a plurality of tasks dates can be scheduled into or removed therefrom (*see, e.g.*, specification, p. 15, lns. 1-2, p. 16, lns. 5-22).

The present invention then analyzes the movement of task dates into and out of the relevant tasking horizon to assess the accuracy with which the estimated dates were predicted. In other words, the progress of the various tasks in a project is measured with respect to this planning window. As such, the period of time encompassed by a tasking horizon is necessarily a window of time which is independent of any specific task in the project. The independence of the tasking horizon from all estimated dates and actual dates for the task related events is illustrated on page 13, lines 20-24, *inter alia*, of Applicant’s specification, which discloses, for example, that “[t]he final step is to assign the tasks 20 that occur during the tasking horizon .... Each day, or at set intervals, the system checks the unassigned tasks and assigns tasks that fall within the next tasking horizon.” Additionally, page 16, lines 10-22 in the specification explains the concept of “churn” using examples of estimated dates and actual dates being moved into and out of a current tasking horizon.

In contrast, the Office Action indicates that the “tasking horizon” as recited in Applicants’ claims is met by section 3.3.2 and p. 170 in Duncan, *i.e.*, “described in the context of target finish date determination and schedule determination.” (Office Action, p. 3). Page 170 in Duncan, however, is merely a glossary page which nowhere

discloses a tasking horizon as used in Applicant's invention. Section 3.3.2 in Duncan merely provides an overview of the "Planning Processes" that are performed in a project. The portion of this cited section most relevant to Applicant's "tasking horizon" concept is Duncan's "Activity Duration Estimating" and "Schedule Development," both mentioned on page 31 in Duncan.

In order to fully evaluate the teachings of Duncan with respect to Applicant's claimed "tasking horizon," therefore, a closer review of the "Activity Duration Estimating" and "Schedule Development" processes in Duncan is warranted. As indicated in parentheses following the identification of these processes on page 31 in Duncan, these processes correspond to sections 6.3 and 6.4 in Duncan, respectively.

A careful reading of sections 6.3 reveals that the most relevant teaching there is found on page 66 in section 6.3.3.1 entitled "[a]ctivity duration estimates," in which it is noted that "[a]ctivity duration estimates are quantitative assessments of the likely number of work periods that will be required to complete an activity." This is quite different from Applicant's "tasking horizon," which is an objective time frame and is not defined in relation to any specific task or activity, or the expected duration for performing any specific task or activity.

Similarly, the most relevant discussion in section 6.4 is found in subsection 6.4.3.1 entitled "[p]roject schedule" on page 69 in Duncan, which discloses "planned start and expected finish dates for each detail activity." The "planned start and expected finish dates" of Duncan most closely correspond to the "predicted dates" disclosed and claimed in the present application, and not the term "tasking horizon." Moreover, if a tasking horizon is defined to be the period of time encompassed by the predicted start and stop dates of a task, as proffered in the Office Action, how can a predicted (estimated) date be created in, moved out of, or moved into a current tasking horizon,

as discussed on page 16, lines 10-13 in Applicant's specification, if the estimated date itself defines the beginning or end of the tasking horizon? Clearly, it is impossible to move a task date into or out of a tasking horizon if the time span of the tasking horizon is defined by the task date itself. Based on the "definition" of the term "tasking horizon" used by the Office Action, any movement of a task date/estimated date would serve to shift the tasking horizon as well. When the passages in Duncan cited in the Office Action are considered in light of the actual meaning of the term "tasking horizon" in accordance with Applicant's invention, it is readily apparent that the cited passages do not anticipate or render obvious the process segment of "setting a tasking horizon" as recited in Applicant's claims.

Applicant further notes that section 6.5.3.1 entitled "[s]chedule updates" on page 72 in Duncan teaches that "[r]evisions are changes to the scheduled start and finish dates in the approved project schedule. As in the other sections of Duncan mentioned above, or for that matter, the entire book, there is absolutely no mention or contemplation of an objective time frame smaller than the project time frame which is independent from the tasks or activities of the project, as is Applicant's term "tasking horizon."

As demonstrated by the analysis above, the unique concept of framing the progress of a project through a sequence of fixed time periods, as defined by the term "tasking horizon" in the claimed invention, is not taught or suggested in Duncan.

Levinson also fails to teach or suggest the concept of a tasking horizon as defined and used in connection with the claimed invention, and as such, also fails to teach or suggest any of the elements recited in Applicant's claims which are performed in relation to such tasking horizon.

## B. Verbs

Claim 1 also recites “for each of said at least one task related event for each of said plurality of tasks, associating at least two predetermined verbs with the respective task related event,” and “for each actual date received, receiving a verb associated with the respective task related event, said received verb being one of said at least two predetermined verbs.” Similarly, claim 10 also recites that the management module associates “at least two predetermined verbs with [each] task” and that the at least one task assignment station enables the entering of “a selected one of said at least two predetermined verbs for each actual date entered” for the task related events.

In addition to lacking any teaching or suggestion of a “tasking horizon” in accordance with the present application, Duncan also fails to teach or suggest “associating at least two predetermined verbs” with each task related event as recited in claims 1 and 10. As described in the context of the present invention, “verbs” are part of a predefined and structured set or sets of words and phrases (or reasons) that have been programmed into the modeling system of the present invention, so as to enable a standardized dialogue between project managers and project workers. (See, e.g., FIG. 4; specification p. 6, lns. 13-22, and p. 12, ln. 22 – p. 13, ln. 13). For example, Applicants’ specification describes the inventive system as including the following processes:

“Once the tasks in a project have been determined, the next aspect of the present invention is the planning of the tasks” (p. 11, lns. 20-21). “The next step is to assign verbs [ ] 18 to each task” (p. 12, ln. 22). Then, “[t]he final step is to assign the tasks 20 that occur during the tasking horizon” (p. 13, ln. 20).

This process sequence is visually summarized in FIG. 4, which shows a flow chart of an “employer task assignment stage” 10 of the invention. As can be seen in

FIG. 4, the step of “selecting verbs” 18 occurs after the step of identifying a tasking horizon 16, and before the step of “assigning tasks” 20 to specific workers to perform the tasks. Categories of pre-selected “verb” sets are discussed in Applicants’ specification on page 13, for example. It can be seen, therefore, that the term “verb” as used in the present invention is a predefined, structured set or sets of words and/or phrases selected during the planning stages of the project, before the tasks are assigned to be performed by specific workers.

The Office Action asserts that the process segment of “associating at least two [] verbs with [each] task related event” as recited in Applicants’ claims is met by section 4.3.3.3 in Duncan, entitled “[l]essons learned” (Office Action, p. 4). Section 4.3.3.3 in Duncan (p. 46) states that “[t]he causes of variances, the reasoning behind the corrective action chosen, and other types of lessons learned should be documented so that they become part of the historical database for both this project and other projects of the performing organization.” Thus, it can be seen that the “lessons learned” in Duncan merely reflect the generalized concept and goal of learning from the past, and is not restricted to associating predetermined words or phrases to be selected later by a worker. Nowhere in the cited section of Duncan, or, for that matter, anywhere in Duncan’s entire disclosure is there any suggestion of a set or sets of predetermined, structured words or phrases associated with the tasks or task related events of the tasks during a planning phase of the process, as defined by the term “verbs” used in the present invention.

Applicant notes that Levinson also does not teach or suggest associating predetermined, structured words or phrases with tasks or task related events for later selection by a user, as claimed in the present application.

C. Automatically updating project status in real time

Independent claims 1, 10, 24 and 29 each recites a process step, a module or a system which automatically updates the project status in real time, based on captured information regarding project tasks or task related events.

The Office Action concedes that Duncan does not disclose this claimed feature. To address this deficiency in Duncan (the previously discussed deficiencies of Duncan in meeting Applicant's claims notwithstanding), the Office Action asserts that such feature is disclosed in Levinson, and that one of ordinary skill in the art would have found it obvious at the time of Applicant's invention to modify the project management guide disclosed in Duncan to incorporate the relevant teaching of Levinson. A thorough review and consideration of Levinson reveals that Levinson does not, in fact, teach or suggest automatically updating a project status in real time in response to captured information.

As pointed out in the Office Action, Levinson discloses at column 4, lines 32-41 the general concept of updating an appointment or event schedule as changes occur for various reasons. Of course Applicant does not dispute that the concept of updating something is known. What must be considered, however, is the claimed process or function of updating in the manner and within the context of the invention as claimed. To this end, Levinson's disclosure does not include the necessary teachings to combine with Duncan to render obvious this feature of Applicant's claimed invention. Specifically, Levinson does not teach or suggest updating a project status (not schedule) in real time in response to information received about the tasks or task related events associated with that project. Levinson's "updating" merely rearranges the user's schedule as needed but does not provide status information regarding any overall activity encompassing each scheduled appointment or event. Thus, Levinson is also an

insufficient supplement to Duncan to render obvious this aspect of the claimed invention.

D. Accessing a look-up table containing historical data

Independent claims 24 and 29, and dependent claims 17 and 19 recite a process and system which accesses a look-up table containing historical data. Claims 17, 20, 24 and 30 further recite comparing a current task table with the look-up table to determine if the information in the current task table is associated with a pre-existing project or task, information of which is contained in the look-up table. Claims 17, 20, 24 and 30 also recite that “upon determining that [the] information in [the] current task table is associated with [] a pre-existing project or task within a pre-existing project, automatically update[ing the] pre-existing project or task.”

The Office Action contends that these features are disclosed on page 109 of Duncan in paragraph 10.3.3.1, and on page 50, paragraphs 5.1.1.4 – 5.1.2.1 in Duncan. These cited passages in Duncan, however, do not disclose accessing a look-up table, comparing the information in the look-up table with information in a current task table, and automatically updating the status of a relevant pre-existing project or task if it is determined that the information in the current task table is associated with a pre-existing project or task, as claimed in the present application. Rather, Duncan discloses in section 5.1.1.4 consideration of historical information, while section 5.1.2.1 discloses selection of a benefit measurement method and a constrained optimization method as the decision models for planning the project. Assuming *arguendo* that the generation of the performance reports disclosed in section 10.3.3.1 in Duncan corresponds to a current task table, as asserted in the Office Action, there is absolutely no mention in Duncan of



comparing the historical information (which is not a look-up table) with information in performance reports. Moreover, neither the historical information nor the performance reports are disclosed or suggested as being used to determine whether information in the performance reports are associated with any pre-existing projects or tasks and automatically updating any such pre-existing projects or tasks in real time.

Furthermore, it is noted these elements of the claimed invention, i.e. the claimed features relating to the creation of a current task table, accessing a look-up table, comparing the information in the two tables, and automatically updating the status of pre-existing projects and/or tasks if information from the current task table is found to be associated with the pre-existing projects and/or tasks, are all performed during the execution of the project, and serve to provide real time information regarding the status of the project. In contrast, the cited sections, *i.e.*, sections 5.1.1.4 and 5.1.2.1 in Duncan, are part of the initial planning stages of a project, and occur before the execution of any project tasks or activities. *See, e.g.*, Duncan, Fig. 5-1 on p. 48 and Figs. 3-4 through 3-8 on pp. 30-35. Thus, the cited passages of Duncan cannot logically be construed to render obvious the above-mentioned aspects of Applicant's claimed invention.

Levinson, like Duncan, also fails to teach or suggest accessing a look-up table containing historical information relevant to pre-existing project and/or tasks. Levinson therefore also does not disclose comparing information from a current task table to information from such look-up table to thereby associate information of a current task table with any pre-existing projects and/or tasks as recited in Applicant's claims.

## E. Risk factor

While claims 6 and 8 are each ultimately dependent from claim 1 and therefore incorporate the patentably distinguishable features discussed above recited in claim 1, claims 6 and 8 also recite additional subject matter which renders the claims allowable over Duncan. Specifically, claims 6 and 8 each recite “computing a risk factor” or the capability to do so. Applicants’ specification describes the term “risk factor” as either a percentage probability that an actual task date will deviate from the estimated task date, for example, or as a standard deviation of time within which the actual task date is likely to vary from the estimated date (specification, p. 19, ln. 3 – p. 20, ln. 6; p. 22, ln. 19 – p. 23, ln. 10, *inter alia*). That is, the risk factor computed in the claimed invention is a statistical number representing a probability.

The Office Action contends that Fig. 11-1 on page 112 and section 11.2 and FIG. 11-2 on pages 115-118 in Duncan, entitled “Risk Quantification,” and sections 11.1 through 11.3, generally, on pages 111-121 renders obvious the risk factor computation recited in Applicant’s claims. (Office Action, p. 5, p. 6). As disclosed in the last paragraph of page 111 and on lines 3-4 on page 115 in Duncan, sections 11.1 and 11.2 relate to the identification of risk events and the determination of which risk events warrant response. Such determination is accomplished by identifying discrete risk events (Duncan, sections 11.1, 11.2.1.2, 11.2.1.3, at p. 115) and evaluating each discrete risk event (Duncan, section 11.2.2, at pp. 115-116), to thereby enable a decision to be made as to which risk events should be addressed (Duncan, section 11.2.3 at p. 117). Section 11.2.2 discloses calculating the potential costs of each risk event (monetary value), whereas section 11.3 discloses the process for risk response development. None of these sections discloses calculating a risk factor as a statistical number representing the probability that an actual date will vary from a predicted date as recited in Applicant’s claims.

Moreover, as shown in Figure 3-5 on page 31, section 11.1-11.3, the “Risk Identification,” “Risk Quantification,” and “Risk Response Development” topics fall within the planning stages of the project, before execution of any tasks have begun. In Applicant’s claim 6, however, the risk factor is recited as being computed based on churn data and received verb data. In order to obtain churn data and received verb data, at least a portion of a task within a project must have been executed. Thus, the cited sections in Duncan do not teach or suggest computing a risk factor during the execution phase of the project, much less based on computed churn and a selected verb, as recited in Applicant’s claim 6.

With respect to the computed risk factor as recited in claim 8, nowhere in the cited passages in Duncan or even the entire disclosure of Duncan is it taught or suggested to compute a risk factor based on previously computed risk factor associated with at least one past project, as recited in the claim.

As demonstrated herein, since the risk factors of the claimed invention are calculated using data received during the execution of the project, Duncan cannot be construed to render obvious this aspect of the claimed invention.

Applicant notes that Levinson is irrelevant to the discussion of risk factors since risk is nowhere mentioned in Levinson’s disclosure.

#### F. Churn

Claim 11 depends from claim 1 and hence incorporates each of the features discussed above attributable to claim 1 which distinguish the claimed invention over the cited prior art. In addition to this, claim 11 further recites “computing churn . . . based on differences between corresponding ones of [] received predicted and actual

dates relative to said tasking horizon." Page 15, line 1 through page 16, line 22, provides a detailed explanation of all the scenarios in which churn is generated, including when a predicted or estimated date differs from an actual date. For example, the specification explains that churn is generated when the actual date for a task event is different from an estimated date, and the actual date is not in the same tasking horizon as the estimated date (specification, p. 16, lns. 14-16, 20-22). Since churn generation is always predicated on a change into or out of a tasking horizon or on the difference of dates in which the estimated and actual dates are in different tasking horizons, if the estimated date is different from the actual date, but both are in the same tasking horizon, then no churn is generated. Thus, churn is only calculated relative to a current tasking horizon. In order to do so, it is therefore essential to first set a tasking horizon which is independent of any task or task related event.

The Office Action concedes that the claimed feature of "computing churn . . . relative to [a] tasking horizon" is not disclosed in Duncan, but then nevertheless asserts that it would have been obvious "to modify Duncan to specifically compute churn . . . because Duncan does disclose the necessary functionality for these computations and these specific features may enhance the desirability of the invention to potential users." (Office Action, p. 6, last para.). There are two inherent defects in this assertion. The first defect lies with the statement that Duncan's "functionality" renders obvious the concept of churn as relevant to Applicant's claimed invention. The second is the logic that the claimed invention is obvious because this feature of Applicant's claimed invention would "enhance the desirability of the invention to potential users." Each of these points will be discussed separately below.

The Office Action contends that paragraph 10.3 on pages 107-108, Fig. 10-2 on page 109, Fig. 10-3 on page 110, and paragraph 11.1.1 on page 113 in Duncan "disclose[s] the functionality for computing churn for said tasks." (Office Action, p. 5).

Nowhere in these cited passages and figures, or anywhere else in the entire reference, does Duncan disclose computing anything relative to a difference between two dates relative to a tasking horizon or any other fixed quantity. The closest concept in Duncan to Applicant's churn computation feature is sections 10.3.2.2 and 10.3.2.4 on page 108 in Duncan, and Fig. 10-3, which discloses only "comparing actual project results to planned or expected results" for cost and schedule variances in section 10.3.2.2, and the concept of calculating the difference between a projected cost and an actual cost in section 10.3.2.4 and Fig. 10-3. These variances in Duncan are simple differences between estimated and actual data. Duncan is completely silent as to the computation of these variances with respect to a tasking horizon or any other fixed standard. As such, Duncan does not disclose or suggest the "functionality" of computing churn as recited in Applicant's claim.

The Office Action admits that Duncan does not disclose computing churn relative to a tasking horizon. Absent specific disclosure or suggestion in the reference of this feature, however, the Office Action's reasoning that it would have been obvious to modify Duncan to perform such a computation because "these specific features may enhance the desirability of the invention" smacks of improper hindsight to justify the conclusion of obviousness. Just because Applicant's invention is desirable does not mean that it is obvious. Proper motivation for modifying Duncan according to the Applicant's claimed invention can only be established upon a showing of such a teaching or suggestion in the prior art, without the benefit of Applicant's disclosure. In *re Sponnoble*, 405 F.2d 578, 585, 160 U.S.P.Q. 237, 243 (CCPA 1969). Accord, *In re Zurko*, 111 F.3d 887, 890, 42 U.S.P.Q.2d 1476, 1479 (Fed. Cir. 1997). See also *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). Since no demonstration has been shown that Duncan or any prior art teaches or suggests

calculating churn relative to a tasking horizon, this aspect of the claimed invention is not rendered obvious by the cited prior art.

Applicant notes that Levinson is unable to supplement Duncan in meeting the claimed feature of churn computation, since there is nothing in Levinson's disclosure which corresponds to the concept of churn (which relies on the concept of a tasking horizon, which is also lacking in Levinson).

G. Motivation for modification of reference must be shown in the prior art

Applicant realizes that various features of the claimed invention, when dissected and viewed independently, are known. For example, Applicant does not dispute that such general concepts such as setting an estimated date for a specific action, recording an actual date of performance for that specific action, updating a store of information, project planning and management in general, etc., are known. However, Applicant submits that the method and system for managing and monitoring a project as recited in claims 1, 6-8 and 10-33 is unique as a whole, and includes unique concepts not previously considered in the prior art.

As recognized by the Federal Circuit in Panduit Corp. v. Dennison Mfg. Co., "[v]irtually all inventions are necessarily combinations of old elements." 810 F.2d 1561, 1 U.S.P.Q.2d 1593, 1603, *cert. den.*, 481 U.S. 1052 (1987). "But the elements are capable of an infinity of permutations," Judge Learned Hand observed in B.G. Corp. v. Walter Kidde & Co., Inc., "and the selections of that group which proves serviceable to a given need may require a high degree of originality. It is that act of selections which is the invention." 79 F.2d 20, 26 U.S.P.Q. 288, 289 (2d Cir. 1935). Thus, in establishing obviousness by combining or modifying prior art references, it is required that the teaching, suggestion or incentive for combining the references be found in the prior art.

The requirement for demonstrating motivation in the references when rejecting a claim under obviousness is well-established in case law. In In re Mills, the Federal Circuit held that “[w]hile [the prior art] apparatus may be capable of being modified to run the way [applicant’s] apparatus is claimed, there must be a suggestion or motivation in the reference to do so.” 916 F.2d 680, 682, 16 U.S.P.Q.2d 1430, 1432 (1990). Similarly, in Ex Parte Levengood, the Board of Appeals reversed a rejection, stating that “[a]t best, the examiner’s comments regarding obviousness amount to an assertion that one of ordinary skill in the relevant art would have been able to arrive at the appellant’s invention because he had the necessary skills to carry out the requisite process steps. This is an inappropriate standard for obviousness.” 28 U.S.P.Q.2d 1300, 1301 (Bd. Pat. App. Int. 1993). *See also* In re Bond, 910 F.2d 831, 834, 15 U.S.P.Q.2d 1566, 1568 (Fed. Cir. 1990); MPEP 2143.01.

Unless Duncan and Levinson, either each by itself or in combination with each other or other cited prior art, provide a motivation to modify the disclosed project management guide of Duncan to meet the invention as claimed by Applicant, any conclusion that Applicant’s claimed invention is obvious over Duncan and Levinson constitutes improper hindsight reconstruction based on knowledge gleaned from Applicant’s own specification, and as such, is impermissible. *See, e.g.,* In re Gorman, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991) (stating that “[i]t is impermissible . . . [to use] the applicant’s structure as a template and [select] elements from references to fill the gaps.”). *See also* MPEP 2141 (instructing that “[w]hen applying 35 U.S.C. 103, the following tenets of patent law must be adhered to: . . . (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention.”). In this case, one of ordinary skill in the art could only have made the leap from Duncan’s general guide to Applicant’s specifically claimed invention by

improperly reconstructing the claimed invention using hindsight knowledge of Applicant's disclosed invention.

H. Claimed invention must be considered as a whole

In order to properly reject the claims under obviousness, the claimed invention, as a whole, must be taught or suggested in the prior art. However, when one of ordinary skill in the art considers the general fabric of the project management guide disclosed in Duncan and the calendar system disclosed in Levinson, and compares them to the general fabric of the project management method and apparatus disclosed and claimed in the present application, it is clear that the claimed invention is uniquely and irreconcilably distinct from Duncan and Levinson. Specifically, Duncan is a generalized outline or guide to be used as a reference for a project manager in managing a project. The claimed invention, however, recites a level of detail in the performance and operation of a project management process and system which is simply not contemplated in the overview guide disclosed in Duncan. Levinson is not concerned with management of an overall project, but merely with scheduling a number of individual and independent events and tasks.

Clearly, both Duncan and the claimed invention are directed towards project management. Both will naturally share some common elements, such as the goal towards efficiency and effectiveness, both involve elements of time, and project related tasks and activities, etc. Similarly, Levinson, like the claimed invention, involves the scheduling of dates. In order to find obviousness, however, it is necessary to look beyond the general similarities which allows each process to be categorized as a project management process (or system), and focus on the distinct features of the claimed invention. Specifically, the claimed invention can only be rendered obvious by Duncan



and Levinson if a reading Duncan and Levinson would conjure up in the mind of one of ordinary skill in the art the specific steps and details recited in the Applicant's claims. In this case, it would not.

For each of the foregoing reasons, Applicant respectfully submits that the claimed invention is not rendered obvious by Duncan and Levinson, with each considered alone or in combination. Withdrawal of this rejection is respectfully requested.

Claims 12-15 have been rejected under 35 U.S.C. 103(a) as being unpatentable over William R. Duncan, "A Guide to the Project Management Body of Knowledge," and further in view of Levinson (U.S. Patent No. 6,047,260) and as supplemented by a taking of Official Notice.

Claims 12-15 each depend ultimately from claim 1, and are thus patentably distinguishable over Duncan and Levinson for the reasons discussed above which are attributable to the latter. These claims, however, recite additional subject matter which, in combination with the features recited in claim 1, further distinguish the claimed invention over the cited prior art. In particular, claims 12-15 are directed to the automatic capture of task performance information and user identification for analyzing various aspects of the user's performance based on the captured information. These features, whether considered alone or in combination with features recited in claim 1, cannot be properly rendered obvious by the cited prior art, supplement with a taking of Official Notice.

The Office Action concedes that neither Duncan nor Levinson specifically discloses the features recited in claims 12, 14 and 15. The Office Action, however, resolves this deficiency by relying on Official Notice to supply the missing "teaching" of

the entire subject matter recited in these claims. This is an improper taking of Official Notice.

MPEP § 2144.03 provides guidance to the examining corps as to when official notice may be taken without supporting documentary evidence or when a rejection may rely on common knowledge in the art, and what evidence is necessary to support the conclusion of common knowledge in the art in the rejection. In particular, this section of the MPEP instructs that “[i]t is never appropriate to rely solely on ‘common knowledge’ in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based.” MPEP 2144.03(A), *citing In re Zurko*, 258 F.3d 1379, 1385, 59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001). This section of the MPEP also states that “an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support.” (*citing Zurko* at 1385, 59 U.S.P.Q.2d at 1697, and *In re Lee*, 277 F.3d 1338, 1344-45, 61 U.S.P.Q.2d 1430, 1434-35 (Fed. Cir. 2002)). Since the assertion in the Office Action that “[t]his presentation media format has been used in the past to provide projects’ status and progress information” is not based on any evidentiary support in the record, the taking of Official Notice of this feature in the Office Action is improper.

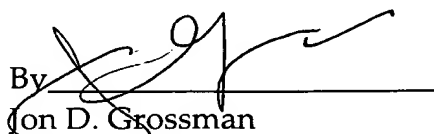
The case law amply supports the discriminating application of official notice and assertion of common knowledge. For example, In *In re Eynde, Pollet, and de Cat* the predecessor court to the Federal Circuit stated that the taking of official notice is only permitted “to supplement or clarify the teaching of a reference disclosure, . . . to ‘fill in the gaps.’” 480 F.2d 1364 (1973) (emphasis added). The “official notice” taken in the Office Action serves much more than to merely clarify or fill in gaps in the teachings of Duncan. Instead, the Office Action’s use of official notice introduces an entirely new feature which one of ordinary skill in the art would never have gleaned from Duncan’s disclosure.

Prior art rejections must be based on evidence. Graham v. John Deere Co., 383 U.S. 1, 17 (1966). Even if an obviousness rejection is based on the level of ordinary skill in the art, prior art references are needed to show what that level of skill was. *See, e.g., In re Kaplan*, U.S.P.Q. 678, 683 (Fed. Cir. 1986). The unrevealed prior art relied upon in the rejection is at the heart of the rejection. Without knowing the prior art on which the rejection is based, Applicant cannot make an intelligent reply as to whether or not the unrevealed prior art does, in fact, disclose or suggest the invention. In accordance with MPEP section 2144.03 (C) and the discussion above, therefore, Applicant requests that the Examiner to produce a reference in a context which renders obvious the claimed invention.<sup>1</sup>

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

Dated: June 23, 2003

Respectfully submitted,

By   
Jon D. Grossman

Registration No.: 32,699

Ellen S. Tao

Registration No.: 43,383

DICKSTEIN SHAPIRO MORIN &

OSHINSKY LLP

2101 L Street NW

Washington, DC 20037-1526

(202) 785-9700

Attorneys for Applicant

---

<sup>1</sup> It is noted that the end of section 2144.03 (B) states that "[t]he applicant should . . . be allowed to challenge the assertion [of official notice] in the next reply after the Office action in which the common knowledge statement was made."